

Hearing:  
August 1, 2000

**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
OF THE T.T.A.B.**

Paper No. 031  
RLS/cv

8/7/00

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Bruce D. Watts

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Serial No. 75/529,793

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Bruce D. Watts, pro se.

Robert Clark, Trademark Examining Attorney, Henry S. Zak,  
Senior Trademark Attorney, Law Office 108 (David Shallant,  
Managing Attorney)

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Before Simms, Wendel and Holtzman, Administrative Trademark  
Judges.

Opinion by Simms, Administrative Trademark Judge:

Bruce D. Watts (applicant) has appealed from the final  
refusal of the Trademark Examining Attorney to register the  
asserted mark BIRTHDAY BALLOONS for mail order gift balloon  
services.<sup>1</sup> The Examining Attorney ultimately issued a final

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<sup>1</sup> Application Serial No. 75/529,793, filed July 31, 1998,  
claiming use since January 1, 1998, and use in commerce since  
July 7, 1998. The application was amended to the Supplemental  
Register on March 22, 1999. Accordingly, the claim by applicant  
at the oral hearing that this application should be considered as  
one under Section 2(f) of the Act, which pertains only to  
Principal Register applications, is irrelevant. The entire

refusal to register on the ground that the asserted mark is generic for applicant's services and therefore incapable of distinguishing applicant's services from those of others. See Section 23 of the Act, 15 USC §1091. Applicant and the Examining Attorney have submitted briefs and an oral hearing was held.<sup>2</sup>

The evidence in this case submitted on behalf of the Office consists of excerpts from the Nexis computer search system showing appearances of the words "birthday balloons," and third-party registrations where the goods have been identified as "birthday party balloons," or similar terminology. The excerpts noted in the Examining Attorney's brief are the following:

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record, however, has been considered in making our determination of registrability.

Although the original description of goods/services was listed as "mail-order gift balloon," and while applicant has not formally amended this description as requested by the Examining Attorney, both applicant and the Examining Attorney have treated this application as a service mark application to register the mark for mail order gift balloon services, or mail order services featuring gift balloons. See applicant's response, filed March 22, 1999, and applicant's reply brief, Point #5. However, even if we were to decide this case as if the description were "novelty gift items, namely, balloons for birthdays," as suggested by applicant at the oral hearing, we would reach the same result.

We note that applicant has attempted to disclaim the words "BIRTHDAY" and "BALLOONS" during the prosecution of this case. As the Examining Attorney has noted, an applicant may not disclaim the entire mark. See *Dena Corp. v. Belvedere International Inc.*, 950 F.2d 1555, 21 USPQ2d 1047, 1051 (Fed. Cir. 1991), TMEP §§1213.07 and 1213.09(b), and cases cited there.

We showed up at her door with a bunch of  
birthday balloons...

The Detroit News, March 8, 1999

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"The company sends workers birthday  
balloons, cards and vouchers..."

The Atlanta Journal and Constitution,  
January 24, 1999

The Examining Attorney maintains that the evidence of record shows use of the asserted mark in a generic sense, that is, to identify a type of balloon. Accordingly, the Examining Attorney argues that the term is a common name for applicant's services of delivering birthday balloons.

Applicant, appearing *pro se*, argues that, when purchasing such balloons, one would ask for "balloons for a birthday" rather than for "birthday balloons." Response, filed April 12, 1999. Applicant also maintains in his reply brief that the asserted mark is "unique, creative, descriptive, distinctive," reflecting applicant's mail order gift service which delivers balloons for birthdays. Applicant acknowledges that "Birthday Balloons" is merely descriptive and would probably indicate balloons for birthdays to the average American, but that applicant was the first to use this phrase. Applicant also devotes a

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<sup>2</sup> Because applicant's petition to make special was granted, the Board is taking this case out of order and deciding it now. See Trademark Rule 2.146 and TMEP §§1102.04 and 1102.04(a).

considerable amount of his time noting the existence of what he regards as examples of similar terms which have been registered by this Office.

In order to determine whether the term is generic as applied to goods or services identified in an application or registration, one looks to how the term is perceived by the relevant public. If this term is understood by the relevant public primarily to refer to the classification or category of goods (or services) at issue, the term is generic. See *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986). Evidence of the public's understanding of a term may be obtained from such sources as dictionaries, newspapers, magazines, trade journals and other publications. In *re Northland Aluminum Products, Inc.*, 777 F.2d 1566, 227 USPQ 961, 963 (Fed. Cir. 1985).

We agree with the Examining Attorney that the evidence of record is sufficient to establish that the asserted mark "BIRTHDAY BALLOONS" identifies to the general public the category or class of applicant's mail order services--that those mail order gift services involve the delivery of balloons for birthdays. Applicant's asserted mark tells the general public that applicant provides balloons for birthdays, or birthday balloons, a term which we find

interchangeable with balloons for birthdays. As such, the asserted mark is incapable of identifying and distinguishing applicant's services from those of others who are engaged in the delivery of birthday balloons.

With respect to applicant's argument that there is an insufficient number of references to "birthday balloons" in the record, we note that the Examining Attorney's evidence consists of six excerpts from U.S. publications (out of "542 stories") in the months of January-March 1999, attached to the March 15, 1999 Office action, and seven excerpts (out of "664 stories") in the months of August-September 1999 attached to the November 3, 1999 Office action. Applicant indicates, on the other hand, that his Nexis search showed that "BIRTHDAY BALLOONS" was used "once in the United States." Applicant's response, filed October 27, 1999. However, this is undoubtedly due to the narrow parameter of applicant's search request, apparently conducted on September 16, 1999 ("DATE AFT 9/6/99 AND BIRTHDAY BALLOONS"). While the Examining Attorney could have submitted more excerpts than he did, we believe that this record is sufficient to demonstrate that the asserted mark is a generic term for applicant's services featuring the delivery of balloons for birthdays.

Although largely irrelevant to our determination, the numerous examples of other registered marks cited by applicant can be distinguished. Some of those registered trademarks, although sometimes consisting of common or ordinary words found in the dictionary, are considered either arbitrary or "suggestive" with respect to the identified goods and services. BURGER KING, DAIRY QUEEN and PIZZA HUT, for example, fall into the "suggestive" (not "merely descriptive" or "generic") category of marks. The fact that a word may be found in the dictionary is not fatal to registration, of course. Other registered marks cited by applicant contain disclaimers of descriptive or generic terminology, or were registered under the provisions of Section 2(f) of the Act, providing for the registration of marks which have acquired distinctiveness. Such marks include UNITED STATES POSTAL SERVICE, KELLOGG'S RAISIN BRAN, KELLOGG'S CORN FLAKES. In any event, each application for registration of a mark for particular goods or services must be separately evaluated. See *In re BankAmerica Corporation*, 231 USPQ 873, 876 (TTAB 1986) and cases cited therein. In that case, we noted that Section 20 of the Trademark Act gives the Board authority to decide appeals from adverse final decisions of Examining Attorneys and that this duty may not and should not be delegated by

adoption of conclusions reached by Examining Attorneys in different cases on different records.

Finally, we should point out that the fact that applicant may have been the first to use a descriptive or generic designation does not justify registration if the term has only merely descriptive and/or generic significance. See *In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018, 1020 (TTAB 1983) and cases cited therein.

Decision: The refusal of registration is affirmed.

R.L. Simms

H. R. Wendel

T. E. Holtzman  
Administrative Trademark Judges  
Trademark Trial and Appeal Board